UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,160	02/09/1999	RICHARD W. CHESTON	RP9-98-096	8471

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Bracewell & Patterson L. L.P.
Intellectual Property Law
P.O. Box 969
Austin, TX 78767-0969

EXAMINER
KEMPER, MELANIE A

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	**Application No.**		**Applicant(s)**
	09/248,160		CHESTON ET AL.
	Examiner		**Art Unit**
	M Kemper		3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 July 2003</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 12-13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Stringer, EP 601,500 in view of Carroll, patent number 6,530,019.

Stringer teaches a personal computer system with usable software comprising: a

processor, a storage device and programs loaded on the storage device in such a way

as to make the programs unusable (col. 5, lines 35-45, col. 13, lines 25-35, 50-55, col.

14, lines 5-10, 15-25, col. 9, lines 3-10); a module associated with the processor for

selecting certain of the programs loaded on the pc including a user input which can add

or delete programs from a listing of programs which are appropriate for that user (col.

15, lines 4-5, 15-20, 40-45); a module associated with the processor and responsive to

the selecting of programs to make the selected programs active and usable (col. 10,

lines 25-30, col. 11, line 50 – col. 12, line 25); and a module associated with the

processor to make the programs which were not selected permanently unusable

including erasing from the storage device the programs not selected (col. 14, lines 39-

40, col. 16, lines 1-5).

Carroll teaches a processor, storage device, and programs loaded on the storage

device in such a way as to make the programs unusable (col. 3, line 60 – col. 4, line 15,

col. 2, lines 20-25). It would have been obvious to one having ordinary skill in the art at

the time of the invention to have made the programs of Stinger entirely unusable since

this would have been adopted for the intended use of requiring acceptance of a

software contract, in this case informing the user of limitations of the trial version, and/or

enforcing payment if the trial version is not free. Alternatively, it would have been

obvious to have the selection of desired programs as in Stinger in the system of Carroll

since this would have been adopted for the intended use of limiting costs to only those

programs that are desired by the user and/or would have allowed the user to save

space on his/her system as taught by Stinger.

3.   Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stringer, EP 601 500 in view of Carroll as above, further in view of Wiedemer, patent

number 5,155,680.

Stringer teaches a method of installing a variable selection of software programs

comprising: loading onto the personal computer storage a plurality of software programs

in unusable form (col. 5, lines 35-45, col. 13, lines 25-30, 50-5, col. 14, lines 5-10, 15-

25); selecting the programs which are needed for the pc (col. 15, lines 4-5, 15-20, 40-

45); converting from unusable form into usable form the programs which have been

selected (col. 10, lines 25-30, col. 11, line 50 – col. 12, line 25); storing the converted

programs in usable form in the pc (col. 11, lines 15-20, col. 8, lines 25-30); and paying

royalties only on programs which have been selected (col. 13, lines 35-45). Stringer

also teaches a method of loading each computer with the superset of programs, each

being in unusable form (original version unusable col. 13, lines 20-35, col. 6, lines 35-

40, col. 15, lines 1-5, 15-25), selecting the subset of programs which are appropriate for

the given computer and converting the programs into usable form and storing them on

the hardfile of the personal computer (col. 13, lines 40-45, col. 11, lines 5-15, col. 11,

line 50 – col. 12, line 25). Stringer also teaches erasing software programs that were

not selected (col. 15, lines 15-20). While Stringer teaches paying royalties only on

programs which have been selected and subsequently converted and stored, Stringer

does not show paying after selection, conversion, and storing in usable form.

Carroll teaches a processor, storage device, and programs loaded on the storage

device in such a way as to make the programs unusable (col. 3, line 60 – col. 4, line 15,

col. 2, lines 20-25). It would have been obvious to one having ordinary skill in the art at

the time of the invention to have made the programs of Stinger entirely unusable since

this would have been adopted for the intended use of requiring acceptance of a

software contract, in this case informing the user of limitations of the trial version, and/or

enforcing payment if the trial version is not free. Alternatively, it would have been

obvious to have the selection of desired programs as in Stinger in the system of Carroll

since this would have been adopted for the intended use of limiting costs to only those

programs that are desired by the user and/or would have allowed the user to save

space on his/her system as taught by Stinger.

Wiedemer teaches a billing method which would include payment after selection,

conversion, and storage in usable form (see at least col. 4, lines 64 – col. 5, line 5, col.

6, lines 50-55, col. 8, lines 25-50). It would have been obvious to one having ordinary

skill in the art at the time of the invention to have implemented the billing method of

Wiedemer where applications are first deciphered in the system of Stringer since the billing of Wiedemer would have offered convenience to the user of Stringer where one payment can be made at one time for the list of software converted rather than repeated payments for each code number of Stringer.

4.   Claims 1-2, 4-6, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stringer and Carroll as above, further in view of Casey et al., patent number 6,243,745.

Stringer teaches a personal computer system initially loaded with software including selected and non-selected software in unusable form (original version unusable col. 13, lines 20-35, col. 6, lines 35-40, col. 15, lines 1-5, 15-25), with the selected software later converted and loaded thereon in usable form (col. 13, lines 40-45, col. 11, lines 5-15, col. 11, line 50 – col. 12, line 25), the computer including a processor, a storage device coupled to the processor for storing programs therein (col. 13, lines 20-55), with selected programs stored in the storage device in usable form after conversion from unusable form having been converted by the processor from unusable form and stored in usable form with non-selected programs not being converted into usable form and creating a list of the selected software for paying royalties on only the selected software (col. 10, lines 25-30, col. 13, lines 20-50, col. 15, lines 40-45). Stringer also teaches the processor includes a software module which erases the non-selected software to remove it from the computer (col. 15, lines 15-25); the computer includes a software module for converting the selected software from an encrypted form into an unencrypted form (col. 6, lines 35-40, col. 11, lines 20-32) and the list of selected

software upon which a royalty is paid includes the software which is converted from encrypted to unencrypted form (col. 15, lines 1-10).

Carroll teaches a processor, storage device, and programs loaded on the storage device in such a way as to make the programs unusable (col. 3, line 60 – col. 4, line 15, col. 2, lines 20-25). It would have been obvious to one having ordinary skill in the art at the time of the invention to have made the programs of Stinger entirely unusable since this would have been adopted for the intended use of requiring acceptance of a software contract, in this case informing the user of limitations of the trial version, and/or enforcing payment if the trial version is not free. Alternatively, it would have been obvious to have the selection of desired programs as in Stinger in the system of Carroll since this would have been adopted for the intended use of limiting costs to only those programs that are desired by the user and/or would have allowed the user to save space on his/her system as taught by Stinger.

Casey teaches selecting programs based on the user's position, or function, and requirements (col. 6, lines 35-40, col. 7, lines 35-45). It would have been obvious to one having ordinary skill in the art at the time of the invention to have selected programs based on the user's position and requirements as in Casey in the system of Stinger, for example, as an option in the order entry window of Stinger, since selecting programs based upon the user's position and requirements would have been adopted for the intended use of providing a procedure which offers time saving advantages of automatically activating needed programs over the individual activation of each program needed of Stinger. It also would have been obvious to have deleted applications

unrelated and unneeded to the user's function since this would have saved space on

the user's computer as taught in Stringer. It also would have been obvious to have

converted the selected software from a compressed form to an uncompressed form

since this is well known in the art for saving disk space and since saving disk space is

an advantage addressed in Stringer.

5.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stringer

and Carroll in view of Casey et al. as applied to claim 1 above, and further in view of

Wiedemer, patent number 5,155,680.

Wiedemer teaches a list of selected software upon which a royalty is paid is the

software which is converted from unusable to usable form (see at least col. 4, lines 64 –

col. 5, line 5, col. 6, lines 50-55, col. 8, lines 25-50). It would have been obvious to one

having ordinary skill in the art at the time of the invention to have implemented the

billing method of Wiedemer where applications are first deciphered in the system of

Stringer/Casey since the billing of Wiedemer would have offered convenience to the

user of Stringer where one payment can be made at one time for the list of software

converted rather than repeated payments for each code number of Stringer.

6.   Claims 9-11, 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Stringer and Carroll in view of Wiedemer as applied to claims 7-8 above, and

further in view of Casey et al., patent number 6,243,745.

Casey teaches selection of software including identifying the user of the computer (fig.

7, col. 7, lines 35-37), identifying the job function of the user and selecting software that

is appropriate for the job function (col. 6, lines 35-40, col. 7, lines 35-45). It would have

been obvious to one having ordinary skill in the art at the time of the invention to have

selected programs based on the user's position and requirements as in Casey in the

system of Stringer, for example, as an option in the order entry window of Stringer,

since selecting programs based upon the user's position and requirements would have

been adopted for the intended use of providing a procedure which offers time saving

advantages of automatically activating needed programs over the individual activation of

each program needed of Stringer. It also would have been obvious to have listed the

software for the user and his job function for selection since this would have been

adopted for the intended use of customization while providing the advantage of limiting

choices of software desired for designated users.

7.   Applicant's arguments with respect to the claims have been considered but are

moot in view of the new ground(s) of rejection.

The applicant argues that Stringer does not teach the software is unusable. To

the extent that the software is encrypted and of limited functions, where full use is not

permitted, and is only fully usable upon payment and receiving the code, Stringer

teaches pre-loading unusable software. The limited functions could be so limited that

only a view of the software is provided, but, overall, cannot be used as is known in the

software art (Stringer, col. 3, lines 37-45). The difference lies in the degree of

functionality chosen by the software developers. However, to the extent that some

functionality exists, the 102 rejection has been removed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

M Kemper
Primary Examiner
Art Unit 3622